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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,650	07/28/2003	Tomoe Kawakami	04329.3102	3613
22852	7590	03/21/2007		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER YUEN, KAN	
			ART UNIT	PAPER NUMBER
			2616	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/627,650	Applicant(s) KAWAKAMI ET AL.	
	Examiner Kan Yuen	Art Unit 2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :07/28/2003
01/12/2004 01/13/2005 04/07/2005 .

Detailed Action

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Objections

2. Claims 1, 6, and 14 are objected to because of the following informalities:

In claim 1, lines 9-10 the term "a unique ID", should read as "an unique ID".

In claim 6, line 4, the term "the unique ID" should be read as "the unique IDs", because there are two different IDs. Similar problem in claim 14, lines 3.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1-7, 10-15, and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line2 12-13, the term "the unique ID" is lack of antecedent basis, because there are two different unique IDs. One ID of its own, and the ID of the partner device. The term "the unique ID" in lines 12-13 does not show which ID. Also in claim 1,

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lines 12-13, the term "set the unique ID again" is considered as vague and indefinite, because the ID was not previously set, therefore it can't be set again. This is also true in claim 14, lines 4-5 with the term "the partner device is set again".

In claim 3, line 17, the term "identification information" is lack of antecedent basis, because there are first and second identification information.

In claim 10, line 3, the term "the second connection unit" has no antecedent basis.

In claim 16, lines 4-5, lines 7-8, and lines 13-14 the term "the partner device", "the second connection unit", and the term "the ID comparison unit", respectively have no antecedent basis.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 6, 9, 10, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamaguchi et al (Pat No.: 6246696).

In claims 1, and 9, Yamaguchi et al. disclosed the methods of a first connection unit configured to connect with a first network; a second connection unit configured to connect with a second network different from the first network; an ID acquisition unit

configured to acquire a unique ID (see fig. 38, box 1610) of a partner device connected to the second network through the second connection unit (see column 38, lines 14-20); an ID comparison unit (see Fig. 38, box 1613) configured to compare a unique ID of its own with the unique ID of the partner device; and a control unit (see Fig. 38, box 1612) which control to set the unique ID again to make the IDs inconsistent, when it is found as a result of comparison by the comparison unit that the unique ID of its own coincides with the unique ID of the partner device (see column 38, lines 42-67). Although the reference does not explicitly teach the methods of a first connection unit configured to connect with a first network, and a second connection unit configured to connect with a second network different from the first network, but the reference shown in Fig. 4, there are two sub-networks denoted as Cn and C4. A reference node cn periodically broadcast terminal ID information as shown in Fig. 14. In Fig. 3, The Another Terminal Identifier Memory section 116 is used for storing newly registered terminal ID from sub-network other than sub-network Cn (Fig. 4 ex. C4). Thus, the reference teaches the apparatus connecting to two difference networks (see column 11, lines 60-67, and see column 12, lines 1-20).

In claim 2, Yamaguchi et al. also disclosed the methods of an ID notification unit configured to notify the partner device connected to the second network through the second connection unit of the unique ID of its own (see column 25, lines 10-35, and lines 48-57, see Fig. 20, box 914, and box 915).

In claim 6, Yamaguchi et al. also disclosed the methods of when the unique ID of its own coincides with the unique ID of the partner device, the control unit controls to set

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again only one of the unique ID of its own and the unique ID of the partner device (see column 38, lines 42-67). The reference said if the two terminal identifiers are the same, the comparison section 1613 recognizes overlapping in the network, and the terminal must be changed.

In claim 10, Yamaguchi et al. also disclosed the method of notifying the partner device connected to the second network through the second connection unit of the unique ID of its own (see column 25, lines 10-35, and lines 48-57, see Fig. 20, box 914, and box 915). The reference said the reference node cn periodically broadcast its terminal ID information so that other nodes can pick up its information.

In claim 14, Yamaguchi et al. also disclosed the method of when the unique ID of its own coincides with the unique ID of the partner device, only one of the unique ID of its own and the unique ID of the partner device is set again (see column 38, lines 42-67). The reference said if the two terminal identifiers are the same, the comparison section 1613 recognizes overlapping in the network, and the terminal must be changed.

Claim Rejections - 35 USC § 103

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al. (Pat No.: 6246696), in view of Jinzaki et al. (Pub No.: 2001/0009547).

For claims 8 and 16, Yamaguchi et al. disclosed the methods of an ID acquisition unit configured to acquire a unique ID (see fig. 38, box 1610) of a partner device connected to the second network through the second connection unit (see column 38, lines 14-20); an ID comparison unit (see Fig. 38, box 1613) configured to compare a unique ID of its own with the unique ID of the partner device; and a control unit (see Fig. 38, box 1612) which control to set the unique ID again to make the IDs inconsistent, when it is found as a result of comparison by the comparison unit that the unique ID of its own coincides with the unique ID of the partner device (see column 38, lines 42-67), as recited in claim 8.

Yamaguchi et al. also disclosed the methods of acquiring a unique ID (see fig. 38, box 1610) of a partner device connected to the second network through the second connection unit (see column 38, lines 14-20); comparing (see Fig. 38, box 1613) the stored unique ID with the acquired unique ID; and connecting the partner device connected to the second network through the second connection unit, when coincidence between the unique IDs is confirmed by the ID comparison unit (see column 38, lines 42-67), as recited in claim 16.

However, Yamaguchi et al. did not disclose the methods of an ID storage unit configured to store in advance a unique ID of the partner device, as recited in claims 8, and 16.

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Jinzaki et al. also teaches the method of an ID storage unit configured to store in advance a unique ID of the partner device (see paragraph 0516, lines 1-8, see Fig. 32 box 625), as recited in claims 8 and 16. The motivation for using the method as taught by Jinzaki et al. in the network of Yamaguchi et al. being that it stores network addresses from two or more different networks.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al. (Pat No.: 6246696), in view of Bergek et al. (Pat No.: Pub No. 2004/0037284).

For claims 3 and 11, Yamaguchi et al. disclosed all the subject matter of the claimed invention with the exception of a reply unit configured to return the second identification information in response to an inquiry about identification information from the partner device connected to the first network through the first connection unit, as recited in claims 3, and 11.

Bergek et al. from the same or similar fields of endeavor teaches the method of a reply unit configured to return the second identification information in response to an inquiry about identification information from the partner device connected to the first network through the first connection unit (see paragraph 0042, lines 5-9, see fig. 1, box 201). The motivation for using the method as taught by Bergek et al. in the network of Yamaguchi et al. being that it responses to the request for IP addresses.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al. (Pat No.: 6246696), in view of Takeda et al. (Pat No.: Pat No.: 6512767).

For claims 7 and 15, Yamaguchi et al., disclosed all the subject matter of the claim invention with the exception for a connection state change detection unit configured to detect a change in connection state on the first network; and a connection state change notification unit configured to notify the partner device connected to the

second network of the change in connection state detected by the connection state change detection unit, as recited in claims 7 and 15.

Takeda et al. from the same or similar fields of endeavor teaches the methods of a connection state change detection unit (see Fig. 6, box 602) configured to detect a change in connection state on the first network; and a connection state change notification unit (see Fig. 6, box 604) configured to notify the partner device connected to the second network of the change in connection state detected by the connection state change detection unit (see column 7, lines 55-67, and see column 8, lines 1-2). The motivation for using the methods as taught by Takeda et al. in the network of Yamaguchi et al. being that the transmission medium 602 monitors transmission medium and for detecting initialization of the transmission media.

Allowable Subject Matter

7. Claims 4, 5, 12 and 13 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. The prior art failed to teach the methods of a connection limit notification unit configured to notify a user of information related to a connection limit to the partner device on the basis of a detection result of the number of partner devices by the device count detection unit, as recited in claims 4, 5, 12 and 13.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Jungck et al. (Pat No.: 7114008), Ymamoto (Pat No.: 6044076), Blair (Pat No.: 6665367) and Tsuchiya et al. (Pub No.: 2002/0093960), are show systems which considered pertinent to the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kan Yuen whose telephone number is 571-270-2413. The examiner can normally be reached on Monday-Friday 10:00a.m-3:00p.m EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky O. Ngo can be reached on 571-272-3139. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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